

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. After amending the claims as set forth above, claims 1-18, 25-29, 35-37, 39-42, and 44 remain pending in this application.

Applicants would like to thank the Examiner for the careful consideration given to the claims.

**Consideration of Claim 37**

Claims 2-4, 6-8, 10-18, 25-29, 35, 37, 39-42, and 44 continue to be withdrawn from further consideration as being drawn to a nonelected species. Applicants respectfully renew their request that claim 37 be considered on the merits. The PTO established in the Office Action dated 8/25/2005 that claim 37 was generic. (See page 2 of the Office Action of 8/25/2005.) Applicants acknowledged that claim 37 was considered generic in the Reply filed on 3/20/2006. Furthermore, claim 37 is not limited to one of the listed species stated in the Office Action of 8/25/2005. Therefore, Applicants respectfully submit that claim 37 was improperly withdrawn from examination and should be considered by the PTO. If the PTO believes that claim 37 is not generic, Applicants respectfully request an explanation for why claim 37 is not generic and which species is claim 37 considered to be.

**Rejection of Claims 1, 5, 9, and 36 based on 35 U.S.C. 112**

Claims 1, 5, 9, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and under 35 U.S.C. 112, second paragraph, as being indefinite. For at least the following reasons, these rejections are traversed.

As to the rejection based on the written description requirement, the PTO asserts that there is no disclosure of the shoe set "set apart from each other by a distance of the width times an integer." It is respectfully submitted that there is such disclosure. For example, original claim 2 recited the feature "wherein the shoe set comprises a first shoe of a width, and a second shoe of the width at a distance of the width times an integer from the first shoe." The original claims are part of the disclosure, as filed, and can satisfy the written description requirement. For example, MPEP 2163 states:

It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification...There is a strong presumption that an adequate written description of the claimed invention is

present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

Additionally, it is respectfully submitted that the feature “a shoe set comprising a first shoe of a width and a second shoe of the same width spaced apart from each other by a distance of the width times an integer” is supported elsewhere in the specification, such as the original specification at page 9, line 21 to page 11, line 1 and Figs. 4-9. For example, the formula,  $T:L:f = n:1:n$ , on page 9, line 26, indicates the amount of feed “f” and the distance (or shoe interval) “T” are the same for the integer “n” in which f and T equal the shoe width “L” times the integer. Figs. 4-9 show in detail the relationship between the shoe width, the distance between two neighboring shoes, and the amount of feed. Given these disclosures, there is ample support to satisfy the written description requirement for the subject matter of claims 1, 5, 9, and 36.

As to the rejection based on indefiniteness, the PTO has not asserted that the terms themselves are unclear but only that, because the limitation of the shoe set “set apart from each other by a distance of the width times an integer” lacks support in the disclosure, the new amended claims are unclear. First, it is respectfully submitted that the terms within the claims are clear because there is adequate disclosure in the specification, for example, page 9, line 21 to page 11, line 1 and Figs. 4-9 of the specification. Second, the claim terms themselves are clear as only terms well known and discernable to one with ordinary skill in the art are used, as in accordance with MPEP 2173.02 which states: “a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004).” Thus, given the use of the particular claim language and the support in the written description, the language provided in claims 1, 5, 9, and 36 is clear and definite.

For at least these reasons, favorable reconsideration of these rejections is respectfully requested.

#### Rejection of Claims based on Judge and Cothrell

Claims 1, 5, 9, and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,682,444 (“Judge”) in view of U.S. Patent 4,525,955 (Cothrell). For at least the following reasons, this rejection is traversed.

Claim 1 (as amended) recites “a shoe set comprising a first shoe of a width and a second shoe of the same width spaced apart from each other by a distance of the width times an integer...wherein the film feeder is configured to feed the film by an amount of the distance.” Neither Judge, Cothrell, nor any combination thereof discloses this feature, as conceded by the PTO. However, the PTO asserts that it would have been obvious to provide any spacing of the shoes desired “since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.” (Paragraph 7 of the office action.) This rejection is improper because the PTO has not presented any prior art or evidence aside from the present disclosure that the spacing of the shoes is a result effective variable. According to MPEP 2144.05, “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).” In this case, the PTO has not provided support aside from the present disclosure that the spacing of the shoes is a result effective variable. Because it has not been established in the prior art that the spacing of the shoes is a result effective variable, there is no support for the assertion that one with ordinary skill in the art would be motivated to optimize the shoe spacing.

Furthermore, claim 1 requires that the film feeder is configured to feed the film by an amount of the distance of the width times an integer. Judge does not teach or suggest this film feeder but merely discloses “a predetermined length of new abrasive material is brought into the shoe assembly.” (Column 4, lines 42-46 of Judge.) Cothrell does not cure this deficiency. Thus, claim 1 is not rendered unpatentable over the prior art.

Claims 5 and 9 depend from and contain all the features of claim 1, and are allowable therewith for at least the same reasons as claim 1, without regard to the further patentable features contained therein.

Claim 36 (as amended) recites “a shoe set comprising a first shoe of a width and a second shoe of the same width spaced apart from each other by a distance of the width times an integer...wherein the film feeding means is configured to feed the film by an amount of the distance.” Neither Judge, Cothrell, nor any combination thereof discloses or suggest these features because the PTO has not established that the spacing of the shoes is a result-effective variable. Also, any combination of Judge and Cothrell does not teach or suggest the claimed film feeding means because Judge merely discloses “a predetermined length of new abrasive

material is brought into the shoe assembly” (column 4, lines 42-46 of Judge), and Cothrell does not cure this deficiency. Thus, claim 36 is not rendered unpatentable over the prior art.

For at least these reasons, favorable reconsideration of the rejection is respectfully requested.

Allowability of Claim 37

Although claim 37 had not been examined, claim 37 is allowable because it recites “wherein the shoe set comprises a first shoe of a width and a second shoe of the same width spaced apart from each other by a distance of the width times an integer...feeding the film by an amount of the distance.” Neither Judge, Cothrell, nor any combination thereof discloses or suggests these features. Thus, claim 37 is not rendered unpatentable over the prior art.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 1/24/2007

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5426  
Facsimile: (202) 672-5399

By Matthew J. Kremer

Glenn Law  
Registration No. 34,371

Matthew J. Kremer  
Registration No. 58,671